

Attorney Docket No. Q64932
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/891,182

REMARKS

Claims 1-11 are all the claims pending in the application.

Applicants have amended claim 6 to address the objection for informalities.

Claims 1-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Linkola (WO 99/41927) in view of USP 6,233,448 to Alperovich et al. Applicants respectfully traverse these rejections, and request reconsideration and allowance of the claims in view of the following arguments.

Claim 1 of the present application recites a method of managing the operation of a mobile terminal of a telecommunications network wherein the operating feature specific to an area is applied as soon as the mobile terminal is located in that area. The Examiner has agreed that Linkola does not teach that the operating feature specific to an area is applied as soon as the mobile terminal is located in that area. However, the Examiner has asserted that such limitation is known in the art, citing Alperovich. The Examiner then combined Linkola and Alperovich, and rejected the claims. Applicants respectfully disagree, and assert that the Examiner's combination of the prior art is based on improper hindsight.

In the Response filed on July 22, 2004 (the "July 2004 Response"), Applicants argued that Linkola relates to change of a mobile station's service profiles tied to different connections of the mobile station, e.g., IMSI (International Mobile Subscriber Identity) numbers, or MSISDNs (mobile station's connection numbers), or subscriber records each has its own IMSI number and MSISDN. As shown in Fig. 4 of Linkola, to change the service profile, connection to network must be exchanged, either by changing to a new MSISDN, or by changing to a new

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IMSI. However, Alperovich relates to activation and deactivation of services of a mobile phone when keeping the same connection with its network. As shown in Fig. 1 of Alperovich, when a mobile station 14 is within a certain distance of a preselected location, calls to the mobile station 14 will be forwarded to a wireline phone 12 to avoid airtime charges. If the connection between the mobile station 14 and its network is disrupted, the activation and deactivation of services will fail.

The Examiner has stated that Applicants' arguments are that Linkola is related to changing service profiles of a mobile station, and Alperovich is related to activating and deactivating of a feature based on the location of the mobile. However, the Examiner has missed Applicants' main point: Linkola is about changing a mobile station's service profiles via changing its network connections, while Alperovich is about changing a mobile station's service profiles when keeping the same network connections. The two references solve distinct problems by different methods.

In the Linkola system, the mobile stores in its own memory the location area identity (LAI) of the location area covered by the base station controller (BSC) to which it is connected. The mobile also maintains a record of different locations and the connections that are to be used by this subscriber in each location. The mobile regularly receives LAI information from the BSC and compares the received information to its stored information to see if the location has changed. If the location has changed, the system then looks at its stored connection information to see if the connection to be used in the new area is the same as the connection already being

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used. If not, then a change is made. Thus, Linkola is only concerned about switching connections when the location changes.

If one of ordinary skill in the art were to consider the two references, it would be seen that when moving from one location to another, Linkola changes connections if appropriate. It would then be seen that Alperovich et al has nothing to do with changing connections, and would not help with the problem to which Linkola is addressed. One could perhaps combine the teachings of the references by having the Linkola location determination and connection changing system work exactly as disclosed in Linkola and to have as a separate feature the location determination and feature activation system of Alperovich et al. But the two systems are really independent of one another and there is no motivation to combine the teachings in this manner.

The Examiner has stated that the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art, citing *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). However, the cited references do not suggest adding Alperovich's feature, activating certain feature when the mobile station is within a specific area while keeping the same network connection, to Linkola where service profile is tied to the subscriber connection - the MSISDN number or IMSI number - so that service profile cannot be exchanged without exchanging the network connection (Linkola, page 5, the first full paragraph).

Even if the feature picked by the Examiner from Alperovich, activating certain feature when the mobile is within a specific area while keeping the same network connection, is known in the art, it is irrelevant to the purpose, the problem solved, and the solution of Linkola. The

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subscriber connection exchange part is an essential part of Linkola's mobile stations, as shown in Figs. 3 (element 33) and 5 (the element at the lower left corner) of Linkola. Changing connection in mobile phone - so as to change the service profile - is an essential step of Linkola's method, as shown in Figs. 6 (step 68), and 8 (step 83). Fig. 4 of Linkola shows that the switching between an IMSI and four MSISDNs, each of which is tied to a service profile. Fig. 9 of Linkola shows the exchange between a connection code 1 and a connection code 2.

Nowhere in Linkola mentions the need for changing a service profile without changing a network connection. There is simply no reason for a skilled artisan to pick the feature, activating certain feature while keeping the same network connection, and add it to Linkola. Adding the feature to Linkola, as the Examiner has suggested here, is impermissible hindsight reconstruction.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). However, as discussed above, Linkola does not suggest in anyway the desirability of the feature picked by the Examiner from Alperovich, activating certain feature while keeping the same network connection, even if the feature is known in the art.

From the foregoing, Applicants respectfully resubmit that claim 1 and its dependent claims 2-11 are patentable.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

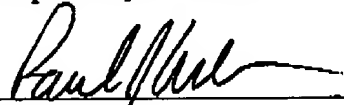
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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Paul J. Wilson
Registration No. 45,879

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: January 12, 2004

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT UNDER 37 C.F.R. § 1.116 is being facsimile transmitted to the U.S. Patent and Trademark Office this 12th day of January, 2005.



Thea K. Wagner